

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1, 4 and 6-9 are rejected under 35 U.S.C. 102(b) over the U.S. patent to Lewin.

Claim 3 is rejected under 35 U.S.C. 103(a) over the U.S. patent to Lewin in view of the U.S. patent to Kondo.

Claims 3 and 5 are also rejected under 35 U.S.C. 103(a) over the patent to Lewin, the patent to Kondo, et al and applicant's admitted prior art.

Also, the specification, the drawings and the claims are objected to and the claims are rejected under 35 U.S.C. 112

In connection with the Examiner's objection to the specification, the applicants amended the specification to provide corresponding headings and to eliminate the reference to the claims.

It is believed that the grounds for the formal objections to the specification are therefore eliminated.

The specification has been amended to define the channel 10 provided in the base plate, and claim 6 has been amended to eliminate the orientation of the crease. Therefore it is believed that no changes in the drawings are needed.

The claims have been amended as suggested by the Examiner, and therefore the Examiner's grounds for the objections of the claims and rejections of the claims under 35 U.S.C. 112 should be considered as no longer tenable and should be withdrawn.

After carefully considering the Examiner's grounds for the objection of the claims over the art, applicants amended claim 1, the broadest claim on file, to more clearly define the present invention and to distinguish it from the prior art.

The Examiner applied the U.S. patent to Lewin against the original claim 1. This reference discloses a base plate for a power tool which, according to Figure 8 has reinforcing elements that protrude out from the plane of the metal sheet. The reinforcing elements comprise a circumferential collar (reference numeral 12) and connecting elements 46, 62. The patent to Lewin does not disclose any information whether the base plate is comprised of a metal sheet, and whether the metal sheet is configured as a stamped and bent metal sheet.

The base plate in accordance with the present invention is configured as a stamped and bent metal sheet composed of a light metal alloy. The patent to Lewin does not provide any hint or suggestion related to this feature of the present invention. Although it appeared as if the circumferential collar and the connecting elements are embodied in one piece with the base plate, there is no hint or suggestion about the structure of the base plate, comparable with the above mentioned new feature of the present invention.

According to the general description of the prior art in this application, there are three groups known how to make base plates for electrical power tools. The first group of known base plates includes those that are stamped and bent out of sheet steel. These base plates typically have a circumferential collar and longitudinal reinforcing increases that serve to increase rigidity.

According to the second group, the base plates are made of stamped parts that are made of light metal and do not have circumferential collars.

According to the third group, the base plate include cast components made of light metal alloys which may have circumferential collars as well as reinforcing elements and connecting elements. However, it is expensive

to manufacture these base plates because they require subsequent finishing work. Also, cast components tend to break under impact.

The base plate in accordance with the present invention does not belong to any one of these groups. As defined now in claim 1, the base plate is configured as a stamped and bent metal sheet composed of a light metal (not sheet steel as in group I, not metal alloy as in group III) and is embodied in one piece including all elements that protrude out from the plane of the base plate (not group II which does allow those producing elements).

While the base plate disclosed in the patent to Lewin seems to be made of one piece and has a circumferential collar as well as connecting elements, it is believed that it belongs either to the first group or the third group. Original claim 1 and some dependent claims were rejected as being anticipated under 35 U.S.C. 102(b). In connection with this rejection, it is believed to be advisable to cite the decision in *re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Lewin does not disclose each and every element as now defined in the amended claim 1. Therefore it is believed that the anticipation rejection based on this reference should be considered as not tenable and should be withdrawn.

The U.S. patent to Kondo applied by the Examiner discloses a base plate 151 for an electrical power tool. The base plate 151 is formed of aluminum alloy, as explained in column 6, line 25. Aluminum alloys belong to the group of light metal alloys which are manufactured as cast components. This is the third group of base plates, which was already described as a prior art in this patent application.

The Examiner combined the references and indicated that the new features of the present invention as defined in some claims could be considered as obvious over the combination. Neither the patent to Lewins nor the patent to Kondo or even the combination of these references provides any hint or suggestion to improve a known base plate in a way that the metal sheet of the base plate is composed of light metal and the entire base plate is embodied in one piece. It would not make any sense to combine the base plates nor the patents to Lewin or Kondo, as the base plates of the patent to Lewin is either made of a stamped and bent sheet steel or of cast components. In the latter case, the base plate known by Lewin is identical to the base plate known by

Kondo which is also made of cast components, and the combination of the patents to Lewin and to Kondo could not provide any additional information. In the first case, combining the method of manufacturing known by Kondo (cast components made of light metal alloys) with the base plates known by the patent to Lewin (stamped and bent out of sheet steel) would lead to the nowhere.

Therefore it is believed to be clear that the combination of the references can not be considered as obvious and would not lead to the applicant's invention. In order to arrive at the applicant's invention from the references, the references have to be fundamentally modified, and in particular by including into them the new features of the present invention which are now defined in the amended claim 1.

However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such modification. This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals, which for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

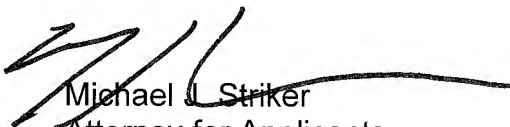
In view of the above presented remarks and amendments, it is believed that claim 1, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker
Attorney for Applicants
Reg. No. 27233